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| 10/647,941 | 08/26/2003 | Jorge Juan Garcia Alonso | P03,0291 | 3067 |

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| EXAMINER |
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HOEL, MATTHEW D

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| ART UNIT | PAPER NUMBER |
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3713

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,941

Applicant(s)

GARCIA ALONSO ET AL.

Examiner

Matthew D. Hoel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/23/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/3/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 19 and 20 have been evaluated on their merits, as these claims cannot be infringed without infringing on Claim 10 from which they depend. See MPEP 608.01(n)(III) and 2173.05(p). They have, however, been rejected under 35 U.S.C. 101 and 112, 2nd paragraph, as they each claim a method and an apparatus in the same claim.

Claim Rejections – 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

3. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

5. Determining the scope and contents of the prior art.
6. Ascertaining the differences between the prior art and the claims at issue.
7. Resolving the level of ordinary skill in the pertinent art.
8. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Choquier, et al. (U.S. patent 5,774,668 A) in view of Nishino, et al. (U.S. patent 6,540,614 B1) and Truong (U.S. patent 5,918,882 A).

10. As to Claim 10: '668 discloses all of the elements of Claim 10, but lacks specificity as to at least two cell control computers, at least two enigma control computers, sensory tests, and tests of ingenuity. '668 teaches an apparatus for controlling an interactive game that manages an interaction between users and game attractions (Abst., Col. 6, Lines 1 to 22). '668 teaches a network of at least one ring (dual fiber ring, Col. 5, Lines 47 to 56). '668 teaches a server element connected to the network (app servers 120, Fig. 1). '668 teaches a switch element connected to the network (service request routers, Claim 39). '668 teaches an electronic storage console (102, Fig. 1) for each game player configured to communicate, identify, and locate the users for the control device of the game to another component (clients 102 communicating with each other in chat mode, Col. 8, Lines 36 to 63; players competing in interactive games, Col. 6, Lines 1 to 22). '614, however, teaches an enigma control computer that include sensory tests and tests of ingenuity connected to the network (game controllers connected to server on network, Col. 3, Lines 60 to 65; sensory tests corresponding to any of five senses, Col. 10, Line 58 to 11, Line 8; player must recognize non-visual sub-image information, and activate perceptive stimulation means corresponding to the sub-image information, Claim 1, Col. 9, Lines 48 to 59; tests of ingenuity, player selects strategy in football game, Col. 14, Lines 10 to 36). It would be obvious to one of ordinary skill in the art to apply the enigma controllers of '614 to the gaming network of '668. '668 is an interactive gaming network that can be played over the Internet (Col. 6, Lines 1 to 22; Col. 5, Lines 31 to 46). '614 can be played in a client-server mode over the Internet (Col. 3, Lines 60 to 65). '614 can be used with a plurality

of players (Col. 2, Lines 6 to 10, Fig. 1), which lends itself to being played over a network. The combination of '668 and '614 would yield a plurality of enigma computers, each with sensory interactivity in a networked environment. The advantage of this combination would be to further the interactivity of the game by allowing players to compete in a networked environment in addition to the interactivity provided by the sensory tests. '882, however, teaches interactive sensory questions of increasing difficulty (sensory questions for all five senses, Fig. 1, Abst.; increasing difficulty with increasing points, Col. 4, Lines 38 to 47). It would be obvious to one of ordinary skill in the art to apply the sensory questions of '882 to the combination of '668 and '614. '614 is capable of asking sensory questions involving any of the five senses (Col. 10, Line 58 to 11, Line 8), like '882. The tactile sub unit of '614 can generate smells, tactile sensations, etc. for any of the five senses, and could be used to electronically provide the questions of '882 Tables 1 to 5, taste, smell, hearing, touch, and sight, respectively). The main embodiment described in '882 is a board game, but it can be implemented as a computer game (Col. 2, Lines 25 to 30), like the game of '614. The result of this combination would be multiple level control computers connected to the network for the varying difficulties of the sensory questions. It is widely known in the art to adapt board games to electronic versions as, for example MONOPOLY™ has been adapted to electronic casino games by WMS Gaming, with numerous references in the patent literature. The advantage of this combination would be to provide a game with a wide variety of questions for all five of the senses that can be played on the apparatuses of '668 and '614 to stimulate and keep the interest of the players.

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11. As to Claim 11: The cell control computers and enigma control computers of the combination of '668 and '614 contain a microprocessor ('614, CPU 101, Fig. 2).

12. As to Claim 12: '614 teaches a microprocessor (101, Fig. 2), a data storage memory (main memory 102, ROM 103, CD-ROM drive 104, Fig. 2), a connector for network connection configured to connect the control element to the network (Col. 3, Lines 60 to 65), and a radio-frequency transmitter/receiver configured to provide communications with the control element (Col. 3, Lines 60 to 65). It is inherent that '614 would have a power supply configured to power the control element (electronic circuits, Fig. 2).

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over '668, '614, and '882 in view of Barnes (U.S. pre-grant publication 2003/0065805 A1, application 10/154,016).

14. As to Claim 13: The combination of '668, '614, and '882 discloses all of the elements of Claim 13, but lacks specificity as to an actuation relay and a radio-frequency reader-identifier that are governed by the control device by radio-frequency. '805, however, teaches an actuation relay; a product or service is delivered when the user is within a predefined distance of the point of sale (Para. 32). '805 also teaches a radio-frequency reader-identifier that is governed by the control device by radio frequency (Para. 264, RFID system). It would be obvious to one of ordinary skill in the art to apply the RFID actuation device and radio-frequency reader-identifier of '805 to the combination of '668, '614, and '882. '805 is meant to be used with gaming software

(Para. 39). '668 balances loads on the application servers based on the number of user requests (Col. 13, Lines 4 to 23). The RFID authentication of '805 could be used to authenticate the user requests of '668. The sub unit of '614 can be a cell phone or a PDA (Col. 15, Lines 4 to 11). '805 can provide authentication for cell phones and PDAs (Para. 39). The advantage of this combination would be to enhance security the security and reliability of the gaming system.

15. As to Claim 15: '805 teaches a chronometer providing a time display on the display viewer (alarm clock application, Para. 39). '805 also teaches a radio-frequency transmitter for transmitting data to other system components and a radio-frequency receiver for receiving data from other system components (Para. 264, RFID system). '805 teaches an audio output device to provide audio information to the user (MP3 files on user's home system, Para. 141; earphone, alarm clock, Para. 37). '805 has an acoustic warning beeper to alert the user of various situations via the audio output device (page, phone call, and alarm clock rings, Para. 37). '805 has an RFID transponder (Para. 264, RFID system). '805 has a message player configured to output messages to output messages to the user via the headphone (headphones, Para. 37; MP3 player, Para. 40). '805 has a multimedia card configured to process multimedia information (Multimedia Access, Para. 57). '805 has a portable power supply in the form of a rechargeable battery (Para. 41).

16. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over '668, '614, and '882 in view of Mir, et al. (U.S. patent 6,450,887 B1).

17. As to Claim 14: The combination of '668, '614, and '882 discloses all of the elements of Claim 14, but lacks specificity as to a quantity of cell control computers and a quantity of enigma control computers being connected to the network with at least two network cards each. '668 teaches a dual ring network (Col. 5, Lines 57 to 65). '668 teaches a cluster of at least two servers connected to the network (Fig. 1). '668 teaches at least two switch elements connected to the network (service request routers, Claim 39). The combination of '668, '614, and '882 teaches cell control computers and enigma control computers as explained in the rejection of Claim 10 above. '887, however, teaches gaming servers connected to the network with at least two network cards each (Col. 10, Lines 59 to 62). It would be obvious to one of ordinary skill in the art to apply the redundant network connections of '887 to the combination of '668, '614, and '882. '668 teaches gateway servers with multiple network cards each (Fig. 5B). '887 can be used over local- and wide-area networks, like the gaming system of '614 (Col. 3, Lines 60 to 65). The advantage of this combination would be to increase the reliability of the game by providing redundant network connections to avoid any disruptions in game play.

18. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over '668, '614, '882, and '805 in view of Powell, et al. (U.S. pre-grant publication 2003/0214885 A1, application 10/146,802).

19. As to Claim 16: The combination of '668, '614, '882, and '805 discloses all of the elements of Claim 16, but lacks specificity as to the electronic storage console being

configured as a bracelet and being configured to accumulate a score obtained by the user in the sensory tests and ingenuity tests. '885, however, teaches an electronic watch (Abst., Fig. 3A). The watch is able to play games (Para. 44), play MP3 files (Para. 43), and communicate by a wireless network (Bluetooth TM, Para. 44). It is inherent that an electronic gaming device is able to accumulate the score of any game played on it. Any electronic watch has counter circuits built into it. It would be obvious to one of ordinary skill in the art to apply the watch of '885 to the combination of '668, '614, '882, and '805. '805 has an RFID system that can be used to authenticate portable devices (Para. 39, 264), and could be used to authenticate an electronic watch communicating on a wireless Bluetooth TM network for gaming purposes (gaming software, Para. 39). The advantage of this combination would be to provide the player with an electronic watch that is more convenient than larger portable devices such cell phones and PDAs.

20. As to Claim 17: '805 teaches an audio output device to provide audio information to the user (MP3 files on user's home system, Para. 141; earphone, Para. 37). '805 has a portable power supply in the form of a rechargeable battery (Para. 41).

21. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over '668, '614, '882, and '805 in view of Wells (U.S. patent 2004/0029636 A1, application 10/213,626).

22. As to Claim 18: The combination of '668, '614, '882, and '805 discloses all of the elements of Claim 18, but lacks specificity as to a hologram projector for projecting a 3D

image. '668 teaches a computer network (Fig. 1). '805 teaches a sound system worn by a user of a game (MP3 files on user's home system, Para. 141; earphone, Para. 37). '668 teaches a control computer connected to the network (application servers 120, Fig. 1). '636, however, teaches a hologram for projecting a 3D image (Fig. 1A). It would be obvious to one of ordinary skill in the art to apply the hologram of '636 to the combination of '668, '614, '882, and '805. The gaming device of '636 is meant to be played in a gaming environment, like the gaming devices of '668 and '614 (Para. 78). Sight questions 7 and 8 on Table 5 of '882 involve depth perception, lending themselves to the use of a 3D display. '882 is meant to be played on a computer in one embodiment (Col. 2, Lines 25 to 30). The sound system of '636 (Fig. 8B) could be used to implement the hearing questions of '882 (Table 3). A proper computer implementation of this game would include electronic apparatuses to simulate as many of the five senses as possible. The combination would yield the hologram projector and the sound system creating an impression that the 3D image is formulating a question to the user. The advantage of this combination would be to enhance the realism of the gaming device by having the visual display being in three dimensions instead of just two.

23. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over '668, '614, and '882 in view of Cordero, et al. (U.S. pre-grant publication 2001/0044339 A1, application 09/789,834).

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24. As to Claim 19: The combination of '668, '614, and '882 discloses all of the elements of Claim 19, but lacks specificity as to providing backup by redundancy to a cluster of servers. '339, however, teaches providing backup by redundancy to a cluster of servers (Para. 11, 35, and 37). '339 replicates server information by the cluster of servers. The combination of '668, '614, and '882 teaches cell control computers and enigma control computers, as discussed in the rejection of Claim 10 above. In '339, data storage device 142 and database 146 mirror data storage device 140 and database 146, respectively. One or more backup servers 2120 may be connected to the public servers by a private virtual connection (Para. 37, Fig. 1A). It would be obvious to one of ordinary skill in the art to apply the redundant servers to the combination of '668, '614, and '882. The gaming network of '339 can be implemented for client devices (Para. 9) such as the PCs of '668 (102, Fig. 1) or the PDAs and cell phones of '614 (Col. 15, Lines 4 to 11). '339 is designed to be used for networked gaming applications (Para. 7). '668 teaches redundancy by providing load shifting between multiple servers running the same application (Col. 1, Line 64 to Col. 2, Line 13). The combination would yield replicating the server information into the cell computers or the enigma computers so that if the servers fail, one of the enigma or cell computers can take the role of the server. The advantage of this combination would be to enhance the reliability of the gaming network by providing redundant backup servers to prevent interruption of game play.

25. As to Claim 20: The combination of '668, '614, and '882 teaches cell control computers and enigma control computers, as discussed in the rejection of Claim 10

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above. '339 teaches providing backup redundancy (primary and backup servers, Para. 35). '339 teaches replacing the functions of one computer with another computer in the event of failure (mirrored backup servers, Para. 37). '339 replaces the functions of all computers with the server element in the event of a failure of all computers (servers 122, 124, 126, 128, 130, 182, 184, 130, 132, and 134, for web, match maker, resource, user id, chat, tournament, ranker, ideal service finder, domain name server, game server, respectively, may be virtual servers on one server or on separate servers, Para. 35). The functions of all of these virtual servers may be provided by a backup server element in the even of a failure on all servers (Para. 35).

Claim Rejections - 35 USC § 101

26. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

27. Claims 19 and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Both of these claims depend from independent Claim 10, which is an apparatus claim. By depending from Claim 10, they incorporate all of the limitations of Claim 10. These claims properly further limit Claim 10 and cannot be infringed without infringing on Claim 10. See MPEP 608.01(n)(III). Claims 19 and 20, however, claim a methods for controlling the apparatus of Claim 10, and so include a method and an apparatus in the same claim. To be statutory subject matter, a claim must be directed to either a method or an apparatus, but not both. Many times in class 463 (gaming), we will see three parallel sets of nearly verbatim claims,

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one for an apparatus for playing a game, another for a method of playing the game, and another for computer-executable instructions stored on a computer-readable medium for executing the steps of playing the game. These are all statutory subject matter, but they only have one type of subject matter in the same claim. These claims should be properly rewritten in independent form as method claims, including all of the limitations of Claim 10. This would result in four independent claims. Only three independent claims have been paid for, so one extra independent claim would have to be paid for (fee worksheet 08/26/2003). Suggested claim language would be: "A method for controlling an apparatus comprising (*limitations of Claim 10*), the method comprising the steps of (*limitations of Claim 19 or 20*)."

Claim Rejections – 35 USC § 112

28. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "the headphone" in Lines 14 and 15. There is insufficient antecedent basis for this limitation in the claim. The examiner believes the applicants intend to cite "a headphone."

29. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 recites the limitations "sensory tests (enigmas)" in Lines 23 and 24 and "tests of skill (challenges)" in Line 24. There is insufficient

antecedent basis for this limitation in the claim. The examiner believes the applicants intend to cite "sensory tests" and "tests of ingenuity" as cited in Claim 10.

30. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites the limitation "(ingenuity enigma in 3D)" in Lines 16 and 17. There is insufficient antecedent basis for this limitation in the claim. The examiner believes the applicants intend to cite "(tests of ingenuity)" as cited in Claim 10.

31. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 19 and 20 improperly claim multiple types of statutory subject matter in the same claim as outlined in the 101 rejections above. The claims are indefinite as it is unclear whether the applicants are claiming methods or apparatuses in these claims. Parallel methods and apparatuses are proper, but they must be claimed in separate claims. See MPEP 2173.05(p).

Citation of Pertinent Prior Art

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The explanation of token ring networking standard IEEE 802.5, downloaded from

http://www.cisco.com/univercd/cc/td/doc/cisintwk/ito_doc/tokenrng.htm, May 13th, 2006

is considered to be relevant. The explanation of token ring networking standard IEEE

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802.5, downloaded from

http://www.cisco.com/univercd/cc/td/doc/cisintwk/ito_doc/tokenrng.pdf, May 13th, 2006

is considered to be relevant. Lelouch in U.S. patent 4,070,102 A teaches an apparatus for sensory control. Davis in U.S. pre-grant publication 2004/0014018 A1, application 10/417,988, teaches a system for human sensory assessment. Gartner, et al. in U.S. pre-grant publication 2003/0113701 A1, application 10/015,442, teach a method of olfactory self-scoring. Luciano, et al. in U.S. patent 6,267,669 B1 teach a hybrid gaming apparatus. Basson, et al. in U.S. patent 6,712,692 B2 teach using video games for physical rehabilitation. Chalupper, et al. in U.S. pre-grant publication 2003/0194095 A1, application 10/408,948, teach individualized training of hearing aid users. Jenkins, et al. in U.S. patent 6,159,014 A teach cognitive and memory training in humans. Corder in U.S. patent 5,387,104 A teaches an instructional system using multiple senses for improving communication skills. Hedrick, et al. in U.S. pre-grant publication 2003/0054881 A1, application 10/246,373, teach RFID player tracking.

Conclusion

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew D. Hoel, Patent Examiner
AU 3713


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TC3700